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IN THE

SUPREME COURT OF THE UNITED STATES.

No. 736

OCTOBER TERM, 1959.

BRIGHT LEAF INDUSTRIES, INC.,
Petitioner,

vs.

E. VERNON STABLER, J. G. HENDRICK, and W. C. GATES, Individually; COLO-RITE MANUFACTURING COMPANY, INC., a Corporation, and GREENVILLE BUTANE GAS COMPANY, INC., a Corporation, Separately and Severally,
Respondents.

BRIEF

Of Respondents in Opposition to Petition for Writ of Certiorari.

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BRIEF

Of Respondents in Opposition to Petition for Writ of Certiorari.

This reply is filed in behalf of E. Vernon Stabler, J. G. Hendrick, W. C. Gates, individually, and Colo-Rite Manufacturing Company, Inc., and Greenville Butane Gas Company, Inc., the respondents who were appellants-defendants below.

OPINIONS BELOW.

The opinions below are adequately set forth in the Petition herein.

JURISDICTION.

Jurisdiction is adequately set forth in the Petition.

QUESTIONS PRESENTED.

In order to fit the facts and law of this case, the questions presented herein, as set forth by petitioner, must be supplemented:

1. Where all elements are admittedly old and no new coaction between the elements of a combination exists, may a patent to such combination be sustained?

2. Where the most pertinent prior art was not cited by the Patent Office against the patent-in-suit, should full weight be given to the presumption of validity established by Title 35, U. S. C., Section 282 (1952)?

3. May a valid patent be granted on devices involving only mechanical skill?

STATUTES, FEDERAL RULES AND REGULATIONS INVOLVED.

The instant case involves in addition to Title 35, U. S. C., Section 103 (1952), Title 35, U. S. C., Section 282 (1952), and Rule 52, Federal Rules of Civil Procedure, the following:

1. The Constitution of the United States, Article I, Section 8, to wit;

> "Congress shall have the power . . .
>
> "To promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;"

2. Title 35, U. S. C., Section 112.

STATEMENT OF THE CASE.

The statement of the case is not adequately set forth in the petition, and respondent points out that:

The claims of the Horne Patent No. 2,472,534 are apparatus claims, not process claims which the petitioner would like for them to be. The Horne patent-in-suit claims as its invention, **not** any process of "moving air," "curing by more than mere heating," "involving low even heat and high uniform air movement" or any "novel concept of curing tobacco based upon drying rather than heating." All of this was an afterthought in behalf of the alleged inventor.

The alleged invention, as set forth in the claims of the Horne patent, is very simple apparatus and includes a thermostat known as a modulating thermostat which regulates the amount of fuel fed through pipes to a number of burners over which heat spreaders are disposed. All of the elements were admittedly old and well known (R. 252, 291, 292). Indeed, the combination of such elements was taught in toto in the patent to Brock No. 1,368,018 and was used extensively by others for curing tobacco in 1938-40 by customers of Florence-Mayo Nuway Company (R. 383 et seq., D. Ex. 12, D. Ex. 21, Deposition of Sheppard Brand and L. L. Hardy).

The Patent Office did not cite the Brock patent and did not know of the extended sales of Florence-Mayo Nuway Company.

Indeed, even the use of gas and the so-called smooth even distribution of heat attributed to the Horne device was shown to be old by the patent to Smith No. 1,811,980.

In short, the Petitioner is yet to point out any element or combination of elements as set forth in the patent

which could be said to be "new" at the time of the alleged invention.

It is curious to note that on pages 5 and 6 of the Petition, Petitioner refers to the Plaintiff's exhibits in developing the prior art and not to the prior art introduced by the Defendants. The prior art cited by Petitioner was a "straw man" to be knocked down.

REASONS FOR DENIAL OF THE WRIT.

This case involves no compelling reason for review by the Supreme Court.

1. No conflicting decisions between Courts of Appeal in various circuits exist in reference to the patent-in-suit.

2. No nation-wide interest is involved in the particular patent-in-suit.

3. No decision, contrary to the decisions of the Supreme Court, was made.

4. No findings of fact of the District Court were set aside.

Instead, the Circuit Court of Appeals for the Fifth Circuit reviewed, as a matter of law, the District Court's decision and, based upon well established principles of law, held that the device claimed in the patent-in-suit did not arise to the dignity of invention.

In **United States v. Esnault-Pelterie**, 303 U. S. 26, 30, 31, the right to review the question of validity was sanctioned in the following language:

> "We are not unmindful of the rule that where, with all evidence before the Court, it appears that no substantial dispute of fact is present, and that the case may be determined by mere comparison of structures and extrinsic evidence is not needed for purposes of

explanation, or evaluation of prior art, or to resolve questions of the application of the descriptions to subject matter, the questions of invention and infringement may be determined as questions of law."

In **Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.**, 340 U. S. 147 (1950), the Court said:

"Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

The device of the patent-in-suit is admittedly an assembly of old elements!

5. The presumption of validity as provided for in Title 35, U. S. C., Section 282, was not disregarded. The presumption of validity had been shattered because the Patent Office failed to cite the most pertinent prior art.

6. It is important to note that there is no new question of law presented. Substantially the same legal questions are present in this case as are present in every case of patent-infringement reviewed by a Court of Appeals. On pages 2 and 3 of the Petition four questions are asked. These questions may be combined and restated as follows:

a. What is the definition of "invention"?

b. What weight should the presumption of validity be given?

Title 35, U. S. C., Section 103 (1952), defines when a patent should **not** be granted, not when a patent should be granted. The definition of "invention" is a question of constitutional interpretation since Article 1, Section 8 of the Constitution grants to Congress the right to "secure for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Thus

the rights of patent protection flow only to "inventors" and the determination of who is an inventor or what is invention is a matter of constitutional interpretation. The 1952 codification of the patent laws (35 U. S. C.) did not change this.

This Court's insistence on the presence of "invention" as a test of patentability has been reiterated again and again in slightly varying language:

Reckendorfer v. Faber, 92 U. S. 347, 357 (1875);
Potts v. Creager, 155 U. S. 597, 608 (1895);
Concrete Appliances Co. v. Gomery, 269 U. S. 177, 185 (1925);
Mantle Lamp Co. v. Aluminum Co., 301 U. S. 544, 546 (1937);
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Co., 340 U. S. 147 (1950).

In the Petition, the Petitioner cites decisions to the effect that old constructions combined in a new way so as to produce a new or improved result are patentable. Yet the apparatus of the patent-in-suit is not combined in any new way. Thus the decisions cited by Petitioner do not support Petitioner's position. The apparatus of the patent-in-suit is combined in an old way and the Petitioner urges patentability only because of asserted better results; but better results alone are not sufficient where only mechanical skill rather than invention was involved.

The Court of Appeals, in its decision, after giving full weight to the findings of fact of the District Court (Petition pp. 30, 31) correctly applied the very same decisions and statutes which the Petitioner now relies upon (Petition pp. 17, 24); to wit: Title 35, U. S. C., Section 103; Palmer Co. v. Luden's, Inc. (3rd Cir. 1956), 236 F. (2d) 496, and Hotchkiss v. Greenwood (1850), 52 U. S. 248 (11 How.), 13 L. Ed. 683 (Petition pp. 31, 32).

To summarize, there is no disagreement rampant except in the eyes of the Petitioner who disagrees with the Circuit Court's decision in the instant case and with the Supreme Court's decision in the A & P case; and there is no confusion as to the clear and explicit meaning of Section 103 of the Patent Act of 1952 except in the brief of the Petitioner. As was so aptly put in the Decision of the Circuit Court: "Horne's tobacco curer may be an effective and useful curing system. As we see it, however, it was an obvious application of gas to tobacco curing, a plumbing operation that required only mechanical skill."

CONCLUSION.

No reason is therefore seen for the review by this Court of the decision below and it is respectfully urged that the Petition be denied.

Respectfully submitted,

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